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In re Application of :
Altmann et al. :
U.S. Application No. 09/762,082 :
PCT No.: PCT/US98/16127 :
Int. Filing Date: 04 August 1998 :
Priority Date: None :
Attorney Docket No.: CM1718F :
For: WRINKLE REDUCING COMPOSITION :

DECISION ON PETITION

This decision is in response to applicants' "Response to Notice of Missing Parts - Completion of Filing Requirement," which is being treated as a Petition under 37 CFR 1.137(b) and Petition under 37 CFR 1.47(a) filed 23 December 2002. The requisite \$1280 petition fee for the filing of a petition under 37 CFR 1.137(b) and the requisite \$130 for a petition under 37 CFR 1.47(a) have been submitted. The above-captioned national stage application became abandoned on 08 April 2001 for failure to submit an acceptable oath or declaration with the time period set forth in the "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) mailed 08 March 2001.

BACKGROUND

On 04 August 1998 applicants filed international application PCT/US98/16127 which claimed no priority date. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the international filing date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the international filing date, or at midnight on 04 February 2001.

On 01 February 2001, applicants filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee; a copy of the international application; and a preliminary amendment.

On 08 March 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 02 December 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment indicating that the application was abandoned for

failure to file a complete response to the Notification of Missing Requirements mailed 28 March 2001 within the time period set therein.

On 23 December 2002, applicants filed the present petition under 37 CFR 1.137(b) and 37 CFR 1.47(a).

DISCUSSION

The above-identified application was abandoned on 08 April 2001 for failure to respond to the Notification of Missing Requirements mailed 08 March 2001.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicants have satisfied Items (2)-(4).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicants submitted the present Petition Under 37 CFR 1.47(a). Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to accept the application without the signature of joint-inventors Earl David Brock and Christian Leo Marie Vermote must be grantable.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Applicant has provided items (1) and (4) under 37 CFR 1.47(a).

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration.

When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

a. Earl David Brock

A review of the present petition reveals that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Earl David Brock. The mailing of the U.S. Assignment and Declaration/Power of Attorney is not considered a complete copy of the application papers. Was a complete application (specification, claims, and drawings) mailed to the missing inventor? Additionally, the declaration of Bridget M. Strobl states that "several attempts have been made to contact Mr. Brock," however, no documentary evidence to support the attempts were provided in the petition.

b. Christian Leo Marie Vermote

A review of the present petition reveals that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Christian Leo Marie Vermote. The mailing of the specification, amendment to the specification of the application, U.S. Assignment, and Declaration/Power of Attorney is not considered a complete copy of the application papers (specification, including claims, drawings, and oath and declaration). The declaration of Bridget M. Strobl states that "[a] reminder (registered letter) to his new address was sent April 25, 2001 but papers have not been returned," however, no documentary evidence to support the attempt was provided in the petition.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers were sent to Earl David Brock and Christian Leo Marie Vermote and when such papers were sent and that Earl David Brock and Christian Leo Marie Vermote have subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

With regard to Item (3), petitioner has not expressly stated the last known address of the missing inventors.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Earl David Brock and Christian Leo Marie Vermote under 37 CFR 1.47(a) at this time.

Therefore, the petition to revive under 37 CFR 1.137(b) cannot be granted at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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